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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/956,909	09/21/2001	Yutaka Akiba	500.35516CX1	3793

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EXAMINER

DINH, TUAN T

ART UNIT	PAPER NUMBER
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2827

DATE MAILED: 11/05/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/956,909

Applicant(s)

AKIBA ET AL.

Examiner

Tuan T Dinh

Art Unit

2827

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 19 August 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) 3-13, 15 and 16 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 2 and 14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☒ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 9/21/01.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Applicant's election with traverse of Specie II (Figures 2-3, claims 1-2, and 14) in Paper No. 9 is acknowledged. The traversal is on the ground(s) that Claims 1-2 read on Specie IV (claims 3-5, and 15) and also, claims 6-9, and 12-13 read on Species II and IV; therefore, claims 1-9, 12-13, and 15 read on Species II and IV, which are relate. This is not found persuasive because the embodiment of Specie II and IV are different structures of a resistor layer connected to first and second conductor layers. For example, Specie II shows the resistor layer is disposed between the first and second conductor layers. The resistor layer can be disposed any positions between the first and second conductor layers. Specie IV shows the resistor layer disposed on a peripheral portion of a first conductor layer, and a second conductor layer has a U-shaped bending both sides of an edge and connected to the resistor layer. Also, the other structure distinct between Specie II and IV, which the peripheral portion of the second conductor layer has a height substantially same as a level of a third conductor and separated by a second dielectric layer.

The requirement is still deemed proper and is therefore made FINAL. Claims 3-13, and 15-16 are withdrawn from further consideration as being drawn to non-elected subject matter.

### ***Double Patenting***

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 1-2, and 14 rejected under the judicially created doctrine of double patenting over claims 1-11, 16-19, and 21-24 of U. S. Patent No. 6,353,540 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows: the limitations of claims 1-11, 16-19, and 21-24 in U. S. Patent 6,353,540 encompass the limitations of instant claims 1-2, and 14, for example: "said resistor layer **joins** said first and second ground layers (U. S. Patent 6,353,540) same function as the instant claims 1-2, and 14 such as "said resistor layer is **connected electrically** to said first and second conductor layers"

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of

the application which matured into a patent. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-2 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Howard et al. (U. S. Patent 5,708,569) in view of Johnson (U. S. Patent 4,179,797).

As to claims 1 and 14, Howard discloses a structure of an electronic apparatus as shown in figures 1-4 comprising:

a first conductor layer (22), a second conductor (28), a third conductor layer (24), a first dielectric material layer (26), a second dielectric material layer (32, and a resistor layer (36A), column 11, lines 30-60, column 12, lines 1-4, wherein;

said resistor layer (36A), said first and second dielectric layers (26, 32), and said third conductor layer (24) are **disposed between** said first and second conductor layers (22, 28);

said resistor layer (36A) is sandwiched by said first and second conductor layers (22, 28);

said first dielectric layer (26) is sandwiched by said first and third conductor layers;

said second dielectric layer (32) is sandwiched by said third and second conductor layers.

Howard does not disclose said resistor layer is connected electrically to said first and second conductor layers.

Johnson shows a substrate (12) as shown in figures 1-5 comprising a resistor material (14) electrically connected to first and second conductor layers (24, 26).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to have a resistor material electrically connected to first and second conductor layers as taught by Johnson to employ the structure of Howard in order to provide interfacial continuity, minimum of impedance mismatch, and minimum of insertion losses.

As to claim 2, Howard discloses the structures shown in figures 1-4 wherein the first, second, and third conductor layers (22, 28, and 24) made by conductor foils, the conductor foils capable of being used as ground and power planes.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tuan T Dinh whose telephone number is 703-306-5856. The examiner can normally be reached on M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David L. Talbott can be reached on 703-305-9883. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-1341 for regular communications and 703-305-1341 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0956.

TD  
November 3, 2002



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